



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/566,228

01/27/2006

Francois Franceschi

33900-192PUS

5744

27799

7590

01/22/2009

COHEN, PONTANI, LIEBERMAN & PAVANE LLP
551 FIFTH AVENUE
SUITE 1210
NEW YORK, NY 10176

EXAMINER

GOSART, TIMOTHY J

ART UNIT

PAPER NUMBER

4118

MAIL DATE

DELIVERY MODE

01/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,228	Applicant(s) FRANCESCHI ET AL.	
	Examiner TIMOTHY GOSART	Art Unit 4118	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/27/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: The language “the optical plane (P-P)” (Line 17) lacks proper antecedent basis and contains figure references. The language is best interpreted as “an optical plane.” Appropriate correction is required.
2. Claim 1 is objected to because of the following informalities: The claim contains a figure reference to “circle (C1).” Appropriate correction is required.
3. Claim 3 is objected to because of the following informalities: The claim contains a figure reference to “angle b.” Appropriate correction is required.
4. Claim 5 is objected to because of the following informalities: The language “the connection pieces” lacks proper antecedent basis. The claim is best interpreted as being dependent on Claim 4. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
6. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language “of diameter greater than the diameter of the capsular bag” (Line 14) positively claims a capsular bag of the human eye. Suggested correction is “of diameter configured to be greater than the diameter of the capsular bag.”

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Southard (US 5197981).

9. Regarding Claim 1, Southard discloses an intraocular implant comprising a circular optic portion 12 defining an edge 21 and a haptic portion comprising two arms 14 extending radially relative to the optic portion (Figure 1). The haptic portion is disclosed to have a main portion 22, a connection end 26 having a thickness that is smaller than the thickness of the main portion forming a flexing line in a direction tangential to the optic portion (Figure 1). Southard discloses a contact end defining a contact edge 28 such that the contact edges 28 form a circle with each other concentric to the optic portion of diameter greater than 10.5 mm (Figure 1 and Column 4, Lines 45-51). The main portion of the haptic arm is disclosed as forming an Angle in a forward direction relative to the optic plane such that the flexing line is closer to the optic plane than the contact edge (Figure 2). The optic portion is disclosed as being displaced towards the wall of the capsular bag by the arms flexing under the stress applied by the capsular bag to the contact ends of the arms (Figure 1 and Column 3, Lines 13-21).

10. Regarding Claim 2, Southard discloses the contact end as being bent rearward towards the optical plane of the optic portion and wherein the connection ends are placed under stress by

Art Unit: 4118

the capsular bag and bear against the wall of the capsular bag (Figure 1 and Column 4, Lines 46-51).

11. Regarding Claim 3, Southard discloses the angle between the main portion of an arm and its contact end as being between 90° and 150° (Figure 1).

12. Claims 1, 4-5, 7-8, and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Cumming (US 6197059).

13. Regarding Claim 1, Cumming discloses an intraocular implant comprising an optic portion 34 (Figure 2) of circular shape and defining an edge, a haptic portion comprising at least two arms 118 (Figure 18) extending radially relative to the optic portion, a main portion 36 (Figure 2), a connection end 38 having a thickness smaller than the thickness of the main portion to form a flexing line (Figure 3) that is tangential to the optic portion, and a contact end having a contact edge disposed on a circle that is concentric about the optic portion and a diameter greater than the diameter of the capsular bag, necessitated by the contact edge being placed under tension by the capsular bag (Figure 1).

14. Regarding Claim 4, Cumming discloses two connection pieces 120 in the form of circular arcs concentric with the optic portion with the ends of each connection piece connected to an arm and concentric on the circle (Figure 18).

15. Regarding Claim 5, Cumming discloses the connection pieces connected at the bend of the arm such that the arms extend beyond the circle on which the connection pieces is disposed (Figure 18).

Art Unit: 4118

16. Regarding Claim 7, Cumming discloses four arms 142 comprising two pairs of arms in which the arms of a pair are projected at 0° relative to each other; and the haptic portion comprising two connection pieces 144 to connect the arms of each pair (Figure 21).

17. Regarding Claim 8, Cumming discloses the length of the connection end 38 as being shorter than the width of the main portion 36 of the arm (Figures 2 and 3).

18. Regarding Claim 10, Cumming discloses the edge of the implant posterior interface surface as forming a square edge with the edge of the optic portion, by forming square edges 38 about the optic portion 34 (Figure 2).

19. Regarding Claim 11, Cumming discloses a groove (appears to comprehend “step”) 40 which extends the square edges 38 (Figures 2 and 3).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cumming (US 6197059). Cumming discloses an embodiment of an intraocular implant comprising four arms projected at 90° relative to the optic portion (Figure 18). This embodiment does not disclose four connection pieces. However, Cumming teaches a second embodiment comprising a plurality of arms 1354 and 1358 and four connection pieces 1356 concentric about a circular arc, being concentric about the circular optic portion 1352 (Figure 67). Therefore, it would have

Art Unit: 4118

been obvious to one having ordinary skill in the art at the time of invention to modify the first Cumming embodiment to include four connection pieces, as taught by the second Cumming embodiment, for the purpose of providing sufficient stabilization of and functional space for the arms.

22. Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Southard (US 5197981). Southard discloses the claimed invention except for the arc of the circle formed by the haptic arms being between 2.5mm and 10.5mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to decrease the concentric arc formed by the haptic arms, for the purpose of providing an implant of appropriate size for varying capsular bag sizes, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hanna (US 20020138140) discloses an intraocular implant comprising various haptic arm configurations.

Kelman (US 20040111152) discloses an intraocular implant comprising various connection end configurations.

Cumming (US 20020068971) discloses an intraocular implant comprising various haptic arm configurations.

Art Unit: 4118

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMOTHY GOSART whose telephone number is (571)270-7826. The examiner can normally be reached on Monday-Friday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Quang Thanh can be reached on (571)272-4982. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Quang D. Thanh/
Supervisory Patent Examiner, Art Unit
4118

/T. G./
Examiner, Art Unit 4118